

NOV 11 2005

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: ) Examiner: Rachel L. Porter  
Edward J. Petrus )  
)  
Serial No. 09/444,660 ) Group Art Unit: 2166  
)  
Filed: November 22, 1999 )  
For: Dietary Supplement Selector and Method

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCESBRIEF ON APPEAL

This is an appeal from the final rejection originally mailed on September 11, 2002. An appeal was filed on April 4, 2003 (App No. 2003-2002). The Appeal decision rendered on July 21, 2004, reversed the decision of the examiner to reject claims 1-5 under 35 U.S.C. § 103(a), and presented a new rejection under 35 U.S.C. §112, 2<sup>nd</sup> paragraph.

A response to the Appeal decision was filed on August 11, 2004, amending the claims in accordance with the decision. A final office action was mailed on December 22, 2004. A Response after Final was filed on February 8, 2005. On February 15, 2005, the examiner held that amendments of claims 1-5 overcame the 35 U.S.C. §§ 112, 1<sup>st</sup> paragraph and 2<sup>nd</sup> paragraph objections but left pending the original rejection of claims 1-5 under 35 U.S.C. § 103(a). A notice of appeal and fee was filed on March 22, 2005.

An appeal brief was filed on May 18, 2005. A Notification of Non-Compliant Appeal Brief was submitted on July 29, 2005 and a Supplement to the Brief on Appeal was submitted on August 5, 2005. This revised Brief on Appeal is submitted to incorporate the supplemental data at the request of the examiner.

No oral hearing is requested. Two additional copies of this brief are submitted and fee submitted.

Real Party in Interest

Edward J. Petrus, M.D.

Related Appeals and Interferences

An appeal was filed on April 4, 2003 (App No. 2003-2002). The Appeal decision rendered on July 21, 2004, reversed the decision of the examiner to reject claims 1-5 under 35 U.S.C. § 103(a), and presented a new rejection under 35 U.S.C. §112, 2<sup>nd</sup> paragraph. A copy of the Appeal decision is attached in the appendix.

Status of Claims

Claims 1-5 were rejected. These claims were previously presented and amended and are reproduced in the attached Appendix.

Status of Amendments

The last amendments to claims 1-5 were submitted February 8, 2005. On February 15, 2005, the examiner held that amendments of claims 1-5 overcame the 35 U.S.C. §§ 112, 1<sup>st</sup> paragraph and 2<sup>nd</sup> paragraph objections and left pending the original rejection of claims 1-5 under 35 U.S.C. § 103(a).

Summary of Claimed Subject Matter

The present invention, as defined in independent claim 1 (Application Pg. 2, lines 10-22), is directed to a method/process of creating a dietary supplement profile for an individual, after completing a health questionnaire (1\*)(Application Pg.3, lines 1-11) and comparing the questionnaire information to a health profile for a person of the individual's age and health history background in a computer data base (2\*)(Application Pg. 3, lines 20-22, Pg. 4, lines 1-13), comparing for differences in the individual's health information to standardized profiles based on age, sex, physical activity, dietary habits, past medical history to achieve optimal health and wellness, and generating a computer-implemented dietary supplement profile (3\*) based on the individual's health information listing the vitamins, minerals, amino acids, enzymes and herbs to achieve optimal health and wellness. Dependent claims 2-3 further comprises incorporating the information provided by a physical examination (5\*)(Application Pg. 3, lines 12-15) and laboratory studies (6\*)(Application Pg. 3, lines 15-19) to refine the health profile. Dependent claim 4 further comprises providing a list of commercial products (4\*)(Application Pg. 4, lines 18-20) that provide the dietary supplements suggested in the optimal health profile. Claim 5 further comprises adding a plan for weight management (Application Pg. 4, lines 12-13). \*refer to Figure 1 of the patent application.

Grounds of rejection to be reviewed on Appeal

Whether claims 1-5 are unpatentable over Summerell et al (USPN 5,937,387) in view of Riley (USPN 5,976,568) under 35 U.S.C. §103(a).

Grouping of Claims

Claim 1 is an independent claim. Claims 2-5 are dependent claims.

Argument

The question before the Appeals Board is whether it would have been obvious to one of ordinary skill in the art, working with Summerell (USPN 5,937,387) in view of Riley (USPN 5,976,568) to invent a method/process of creating a dietary supplement profile for an individual, after completing a health questionnaire (1\*) and comparing the questionnaire information to standardized profiles based on age, sex, physical activity, dietary habits, past medical history to achieve optimal health and wellness in a computer data base (2\*), and generating a computer-implemented dietary supplement profile (3\*) based on the individual's health information listing the vitamins, minerals, amino acids, enzymes and herbs to achieve optimal health and wellness.(Claim 1) The invention further comprises incorporating the information provided by a physical examination (5\*) and laboratory studies (6\*) to refine the health profile.(Claim 2 & 3) The invention also provides a list of commercial products (4\*) that provide the dietary supplements suggested to achieve optimal health and wellness.(Claim 4) And finally by adding a plan for weight management. (Claim 5). \*refer to Figure 1 of the patent application.

The Examiner would have us believe that a person of ordinary skill in the art would be motivated to combine a system that calculates survival rate by determining the users "physiological age" and providing a wellness plan based on risk factors with seven different multivitamin formulations to achieve the applicant's invention.

Claim Rejections - 35 USC § 103**Claim One**1. Modification of Summerell

The Examiner erred when claiming that "Summerell et al teach a method for creating a dietary supplement profile for an individual..." (Office Action 12/22/04, Pg. 6, lines 15-16). The Examiner, in the First Office Action (Pg. 10, lines 6-7) stated that "Summerell et al teach a method for customizing a personal wellness plan for an

individual..." In his abstract, Summerell's patent was claimed to be "[a] System and Method for Developing a Customized Wellness plan for measuring a user's wellness by determining a user's physiological age." Summerell does not use the phrase "dietary supplement profile" in any of the claims, abstract, 30 figures or specifications.

The CCPA and the Federal Circuit has consistently held that when a § 103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). On this basis alone, the use of Summerell as a basis for rejection under 35 U.S.C. § 103(a) is inappropriate and not based on the facts of this application. See Evidence Appendix.

## 2. Claim 1 is distinguished from Summerell

The examiner erred in referencing Summerell as teaching a method for creating a dietary supplement profile by completing a health questionnaire by an individual (Summerell, Figures 4-6, col. 9, lines 15-31)(Office Action 12/22/04, Pg 6, line 17). Figure 4 asks for your height in inches. Figure 5 asks if you wear a seatbelt. Such a question has no significance in determining a dietary supplement profile, but in determining risk and calculating survival rate. Figure 6 asks how often you eat breakfast. Summerell (Col.9, lines 35-37) states that "Information from the health profile questionnaire is then used to determine the user's relative risk stratification level," not to determine a dietary supplement profile.

The examiner erred in stating that Summerell teaches a method to comparing the information gathered from the questionnaire to health standard information for a person of the individual's age and health history background (col 8, lines 30-41; line 53-col9, line 14; line 14; col 11 lines 18-29)(Office Action 12/22/04, Pg 6, lines 18-20). Summerell (col 8, lines 30-41) refers to Fig. 1 which show steps to obtain subscription authentication, and is not a health questionnaire. The examiner admits that "Summerell does not specifically teach that the health standard information ... to which individual's questionnaire information is compared includes standards required for optimal health" (Office Action 9/11/02 Pg. 6, lines 2-4).

The examiner erred in stating that Summerell teaches a method for comparing for differences in the individual's health the (sic) information to standardized profiles based on age, sex (gender), physical activity (e.g. energy expenditure), dietary habits, and past medical history (col 8, lines 30-41; line 53-col9, line 14; col 11, lines 18-29; Table 1)(Office Action 12/22/04, Pg. 6, lines 21-22, Pg.7, lines 1-2). Summerell (col 8, lines 30-41) refers to Fig. 1 which show steps to obtain subscription authentication. Summerell offers no computer-controlled feedback loop by which the consequences of an event send back data that in turn modify that event in the future. The examiner admits that "it is unclear if the system/method of Summerell adjusts for differences between the individuals health information when compared to an optimal health profile then generates a dietary supplement profile suggested for an optimal health profile." (Office Action 9/11/02, Pg. 6, lines 20-21, Pg. 7, lines 1-2). This admission by the examiner nullifies any rejection for obviousness under § 103. The Court in *Jones v. Hardy*, 727 F.2d 1524, 1529 (Fed. Cir. 1984) held that in determining obviousness, one must consider the invention as a whole; small differences between the claims and the prior art can therefore give rise to patentability:

Summerell teaches a method to determine a user's current physiological age (Col.1, lines 10-11, claim 1).. Physiological age is defined as the "calendar age of an average person of the same gender with a comparable risk stratification level." (Col. 11, lines 25-27). Summerell provide various wellness plan options (Col. 3, lines 18-41) suggested to improve one's physiological age (Col. 2, lines 60-65). Summerell uses the information from the health profile questionnaire "to determine the user's relative risk stratification level" (Col. 9, line 35-37), not to create a dietary supplement profile.

The Examiner erred when alleging that Summerell teaches generating a computer-implemented dietary supplement profile listing vitamins and minerals based on the individual's health information (Summerell, Figures 19-28)(Office Action 12/22/04 Pg. 7, lines 3-4). Summerell clearly states that "An object of the present invention [is] to provide a system that counsels individuals in a meaningful way to adopt and maintain healthy behaviors"(Col. 2, Lines 57-59) considering such issues as: driving while intoxicated, eating between meals, education level of spouse, firearms, helmet use, parent's divorce, safety belt use, social contacts, suicide attempt, traffic tickets..."

"among others in the calculation of physiological age." (Col 3, lines 18-41). None of the 38 claims of Summerell teach or suggest the generation of a computer-implemented dietary supplement profile.

Summerell does not teach generating a dietary supplement profile based on the individual's health information. Summerell (Col 10, lines 11-16) discusses mortality rate for smokers. Applicant (Pg. 4, lines 7-9) teaches "If a smoker or in an air-polluted area increase vitamin C to 1 gm, selenium to 400 mcg, beta-carotene to 25,000 IU, vitamin E to 400 IU, copper to 3 mg and zinc to 50 mg." The Examiner again admits that "[t]he primary reference, Summerell et al, does not specifically disclose adjusting for differences between the individual's health information when compared to an optimal health profile, as claimed by the Appellant." (Examiner's brief 6/17/03 Pg. 11, lines 17-19). In fact, no generation of a dietary supplement profile is taught or suggested by Summerell.

The examiner erred in stating that Summerell teaches a method of "generating a computer-implemented dietary supplement profile listing vitamins and minerals based on the individual's health information (Figures 19-28)(Office Action 12/22/04, Pg 7, lines 3-4). Summerell does not teach the generation of a computer-implemented dietary supplement profile, but states that "Fig. 19 shows an example of an age reduction plan window, without selected plan items" (Col. 7, lines 28-29) and does not identify Fig 19-28 as generating a computer-implemented dietary supplement profile. The application clearly distinguishes over the reference to Summerell, which recommends the same amount of vitamin C, vitamin E and folate as in a one-size fits all vitamin tablet, provides no feedback to modify the amount of vitamins, and makes no reference to other vitamins, minerals, amino acids, enzymes or herbs.

The examiner erred in stating that "Summerell teaches a method and system for providing a dietary supplement profile for an individual in which information from an individual's questionnaire is compared to health standard information base on individual's of comparable age, gender and other health risks including physical activity (col 11, lines 18-29)(Office Action 12/22/04 Pg. 7, lines 5-8). On the same page the examiner states that "Summerell does not specifically teach that health standard information .. includes standards stored in a database." (Pg. 7, lines 13-15).

Summerell teaches the recognition of high blood pressure as a risk factor, but offers no dietary supplement profile to counteract the risk. Summerell recommends the use of exercise, stress reduction, salt restriction, weight loss, decrease alcohol consumption and anti-hypertensive medication (Fig. 24). No individual dietary supplement plan is taught or suggested in the recommendation. His wellness plan considers total and HDL cholesterol, but only recommends reducing dietary cholesterol, exercise and an alcoholic drink at night (Fig. 18, 20, 22, 23). The weight loss recommendation in Fig 24 offers no individual plan but suggests a 10% reduction in weight.

In the Applicant's invention, the amount of dietary supplements are adjusted to reflect changes in an individual's needs. See Application, pg 3, lines 22 to pg 4, line 11. Summerell offers no dietary supplement profile listing the vitamins, minerals, amino acids, enzymes and herbs suggested for an optimal health profile, but makes general recommendations to reduce risk factors to calculate a survival rate.

### 3. Claim 1 is distinguished from Riley

The examiner erred in stating that "Riley teaches a method that adjusts for differences in the individual's health profile compared to a health profile and generates a dietary supplement based on the individual's health information. (Col. 7, line 33-col. 8, line 9; col 17, lines 30-40, col 21, lines 35-40)(Office Action 12/22/04 Pg 8, lines 6-9).

Riley teaches a method of providing seven (7) multi-vitamin and mineral formulations, referred to as modules. These modules are described on Column 4, lines 44-67 and column 5, lines 1-21. "Module 1, the basic formula, is directed to the general public and consists of vitamins and minerals essential for the prevention of vitamin and mineral deficiency diseases." There is no mechanism in the invention to determine what vitamin or mineral deficiencies exist. "Module 2 is a Stress Formula." Module 3 consists of "specific doses of vitamin, minerals and other compounds." "Module 4 contains aspirin." "Module 5 is essentially Module 1 combined with about 20 mg of aspirin within the AM tablet." "Module 6 is also essentially Module 1, but combined with about 81 mg of aspirin with the AM tablet." "Module 7 which is the same as the low dose formulation in Module 3, but combined with about 81 mg of aspirin." How does one know which module to take? Riley offers no system/method of determining what modules to take.

Riley teaches away from the invention of the applicant. Riley teaches that "[t]he use of laboratory methods to assess nutritional status, which includes blood and tissue levels of vitamins and their effects (A, C, E, D, etc) on various enzyme systems (B1, B2, B6), is often considered the most reliable method of assessing nutritional status, though these special testing procedures are expensive and do not exist in standard medical offices or in many hospital clinical laboratories (Col. 2, lines 42-49). Riley goes on to state that "certified nutrition assessments, the expenses involved, and the time required to conduct necessary history taking, physical examination and appropriate laboratory testing, it is apparent that consumers are forced into making their own nutrient supplement choices." (Col. 2, lines 62-66). Riley has five (5) claims that outline the multi-vitamin compositions. The health questionnaire, lab studies and physical exam used in the applicant's invention are taught away by Riley. The Supreme Court held in *United States v. Adams*, 383 U.S. 39, 148 USPQ 497 (1966) that one important indicium of nonobviousness is "teaching away" from the claimed invention by the prior art, and that the prior art's teaching away was held to prevent a purported § 103 rejection.

*In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988), support of the issue of obviousness is discussed. In Fine the Court held that the PTO had not established a *prima facie* case of obviousness. "The references applied by the Board and Examiner were improperly combined, using hindsight reconstruction, without evidence to support the combination and in the face of contrary teachings in the prior art." One of the references (Eads) "diverge from and teach away from the invention at hand" as does the Riley reference in the instant application. The Court held that neither reference alone or in combination, suggested the claimed invention.

#### 4. Claim 1 is distinguished from Summerell and Riley

The Applicant's claims differ from Summerell and Riley and a claim of obviousness cannot be made. The CCPA and the Federal Circuit has consistently held that when a § 103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There is no suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. There must also be a reasonable expectation of success. Just as important, the suggestion or motivation to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 – 2143.03 for decisions pertinent to each of these criteria. Applicant therefore submits that the rejection for obviousness based on Summerell and Riley is not legally justified and is therefore improper.

The Examiner withdrew the § 102 rejection and replaced it with a § 103 rejection. A § 102 rejection for anticipation is established only when a single prior art reference discloses each and every element and limitation of the claims at issue, *Carella v. Starlight Archery and Pro Lines Co.*, 804 F.2d 135, 138 (Fed. Cir. 1986), and it was obvious to the examiner that Summerell could not withstand those requirements, thus a two-reference monte was created in the form of a § 103 rejection. In a recent Court decision, *In re Lee*, 61 USPQ2d (Fed Cir. 2002), the Court vacated the Board's decision for failure to meet the adjudicative standards for review under the Administrative Procedure Act. Lee pressed the examiner during prosecution for some teaching, suggestion, or motivation in the prior art to select and combine references that were relied on to show obviousness. In Lee, the Court overturned the Board's decision "that a 'specific hint or suggestion' of motivation to combine was not required."

In the instant case, the applicant also pressed the examiner to explain the teaching, suggestion, or motivation in the prior art that was relied on to show obviousness, and maintained that a claim of obviousness based on Summerell and Riley could not be made. The Examiner argued that "there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves." (Advisory Action 11/18/02, Pg 6, lines 22-23, Pg. 7, lines 1-2). Lee teaches that the examiner must articulate the reasons for that decision, not vaguely state, as the examiner has done in the instant case that "specific portions of each applied reference express articulations of the combinations and motivations for combinations, as well as the scientific and logical reasoning of one skilled in the art at the time of Applicant's invention." (Pg. 5, lines 22-23, pg 6, lines 1-2).

Therefore, applicant questions how a person of ordinary skill in the art would be motivated to combine a system for determining the users physiological age by providing a wellness plan based on risk factors to calculate survival rate with seven different multivitamin formulations to achieve the applicant's invention. It doesn't. Contrary to the Examiner's claim, combining Summerell and Riley does not teach or suggest the Applicant's invention.

As an interesting thought, since Riley teaches away, eliminating it as a reference, that leaves Summerell standing alone. Can a sole reference be used in a § 103 rejection, or does the § 103 rejection convert to a § 102 rejection, which was previously withdrawn? Since the issues of rejection are vague, the rejection by the examiner could be viewed as void for vagueness.

#### **Claims Two to Five**

##### **5. Claim 2 is distinguished from Summerell and Riley.**

The Examiner erred alleging that Summerell teaches a method wherein information from a physical exam can be compared to health profile data and make a dietary supplement profile. (Office Action 12/22/04 Pg. 9, line 3-10).

As the invention is defined by the language in the claims, a review of the 38 claims of Summerel and the 5 claims of Riley, no reference is made to using data from a physical exam to achieve a dietary supplement profile. Applicant's invention teaches that the method "can be further individualized by supplementing information provided by a physical exam which allows the practitioner to input data such as blood pressure, pertinent physical and emotional findings, current medications, body fat analysis, and any contraindications to dietary supplements." (Application Pg 3, lines 13-15).

##### **6. Claim 3 is distinguished from Summerell and Riley**

The Examiner erred when stating that Summerell and Riley teach that laboratory information are compared to health profile data in making a dietary supplement profile. (Office Action 12/22/04 Pg. 9, lines 13-21). A review of the 38 claims of Summerel and the 5 claims of Riley, no reference is made to using data from laboratory test to achieve a dietary supplement profile. No such dietary supplement profile is claimed by Summerell or Riley. Applicant's invention incorporates laboratory studies to provide additional insight into the consumer's health status. "Laboratory studies that could be input into the

database by example comprise: complete blood count and urinalysis, automated blood analyses, serum vitamin levels, hair analyses or essential metabolic analysis for nutritional assessment testing." (Application Pg 3, lines 15-19).

7. Claim 4 is distinguished from Summerell and Riley

The Examiner erred in stating that Summerell teaches a method that also includes adding a list of commercially available products that provide the dietary supplements listed in an optimal health profile. (Office Action 12/22/04 Pg. 10, lines 5-7). The application clearly distinguishes over the reference to Summerell, which recommends the same amount of vitamin C, vitamin E and folate as in a one-size fits all vitamin tablet, provides no feedback to modify the amount of vitamins, and makes no reference to other vitamins, minerals, amino acids, enzymes or herbs. Summerell offers no computer-controlled feedback loop by which the consequences of an event send back data that in turn modify that event in the future. Riley teaches a method of providing seven (7) different multi-vitamin and mineral coated tablets. (Col. 4, lines 44-67; Col. 5, lines 1-21). In Riley, there is no mechanism for determining what vitamin or mineral deficiencies exist, nor is there any system/method of determining which of the seven multi-vitamins to take. Riley does not use any health questionnaire, nor does it generate any health profile. Riley has five (5) claims that outline the multi-vitamin compositions. Applicant's invention "can be further defined into commercially available products, for both the convenience of the consumer or for the benefit of the commercial provider." (Application Pg. 2, lines 20-22).

8. It was not obvious to the Examiner to combine Summerell and Riley

The Examiner stated that "[a]t the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Summerell to compare the individual's questionnaire information to standards stored in a database." (Office Action 12/22/04 Pg. 7, lines 16-19). In the same paragraph the examiner admits that "Summerell does not specifically teach that the health standard information to which individual's questionnaire information is compared includes standards stored in a database." (Office Action 12/22/04 Pg 7, lines 13-15).

It wasn't obvious to the Examiner to combine Summerell and Riley. Riley was not cited in the First Office Action, but in the Final Office Action. After it became

obvious that Summerell could not sustain a § 102 rejection for anticipation, the § 102 rejection was withdrawn (Pg. 18, line 3) and Riley was inserted to claim a § 103 rejection for obviousness when combined with Summerell. Such action by the Examiner violates MPEP § 706.07 which states that going "from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection."

It wasn't obvious to the inventor/pro se-appellant who has standing as one of ordinary skill in the art.

The Court, *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987) held that the PTO "failed to establish a *prima facie* case of obviousness" and stated:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir 1984).

Accordingly, even if all elements of a claim are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention. See *In re Regal* 188 USPQ 132 (CCPA 1975). Neither Summerell or Riley teach or suggest such a combination to arrive at the applicant's invention.

#### 9. No clear issue was developed between the Examiner and applicant

The Examiner erred when stating that the Appellant never indicated that there was any vagueness or lack of clear issues regarding the telephone interview on June 10, 2002. (Examiners brief 6/17/03 Pg. 18, lines 19-20). In fact, during the telephone interview, applicant made claim amendments that were approved as acceptable by the examiner and Supervisory Patent Examiner Joseph Thomas. The amended response was sent on June 11, 2002, with the understanding that any objections were resolved by amendments to the claims, and were acceptable for allowance. Applicant was surprised when a final office action and rejection of all claims was sent on September 11, 2002.

The Examiner erred when stating that Applicant's after final response, received 10/22/02, "does not indicate a lack of clarity in the Examiner's objections ." (Examiner's brief Pg 18, lines 21-22). Applicant protested the Examiner's responses as "void for vagueness" and clearly stated:

MPEP § 706.07 states that "[b]efore final rejection is in order a clear issue should be developed between the examiner and applicant." That has not happened in this case. No clear issue has been communicated to the applicant from the examiner. This case was filed 11/22/99 and the first office action was 3/22/02, twenty-eight (28) months later. Why the rush to close the case? (After final response Pg.2, lines 8-11).

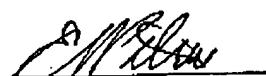
This issue is part of the reason that prompted the appeal, claiming that the office action was not final. The lack of clarity by the Examiner and failure to articulate clear issues for the applicant have led to this appeal.

#### Conclusion

In view of the foregoing, it is clear that Summerell and Riley, taken alone or in combination, do not express, imply or suggest the invention of claim 1. It is also clear that the examiner has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to be obvious in light of the teachings of the references. Thus, the examiner has fallen victim to the insidious effect of the hindsight syndrome.

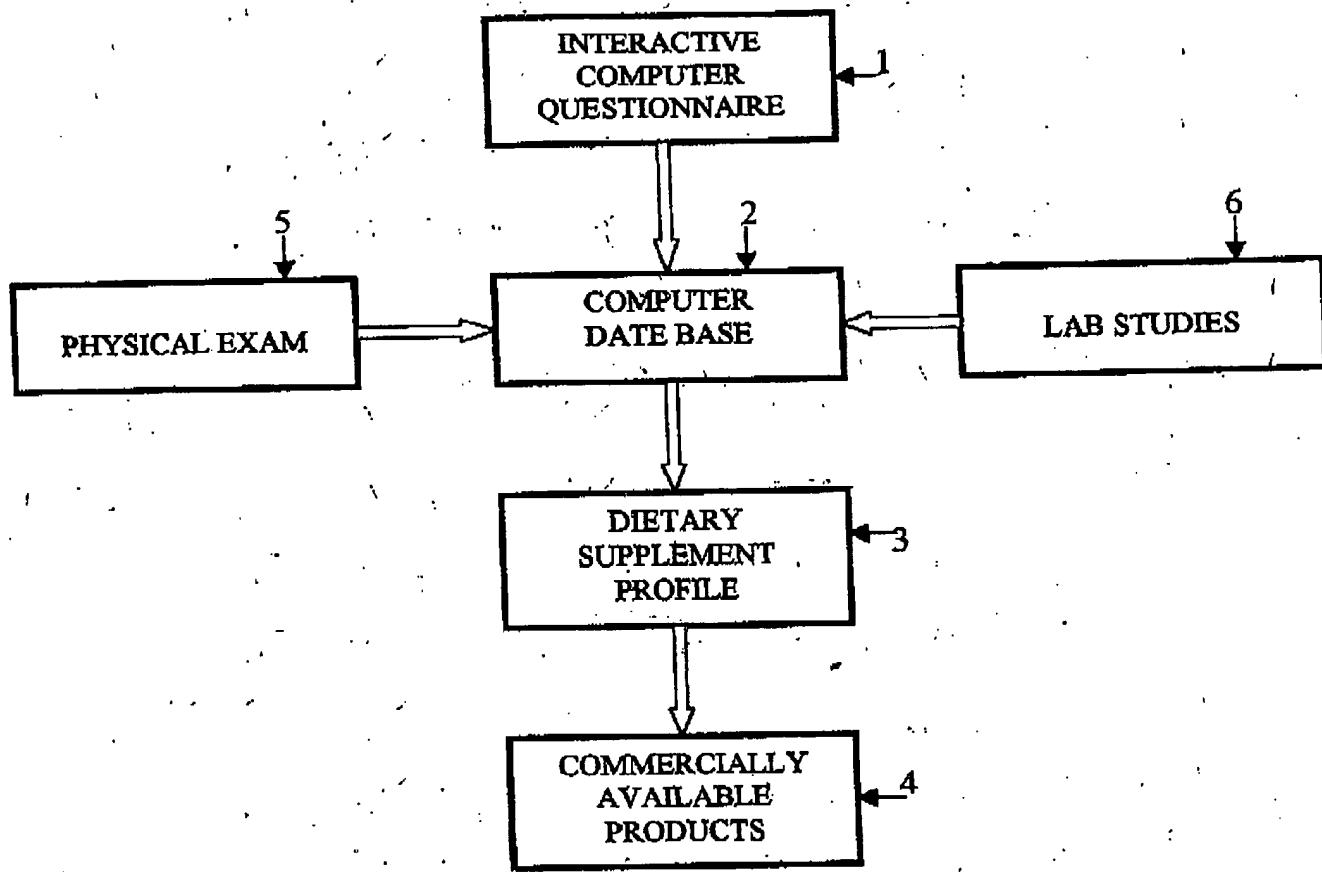
It thus follows that a *prima facie* case of obviousness in the present case has clearly not been established, and that independent claim 1 is therefore clearly patentable. Dependent claims 2-5 are directed to even more details of the specific invention. Therefore, these claims are also in condition for allowance for the reasons indicated above. It is therefore requested that the above rejections be overturned and that claims 1-5 be passed to issue.

Respectfully submitted,

  
Edward J. Petrus, M.D.  
3413 Spanish Oak Dr.  
Austin, Texas 78731  
Tel: (512)-454-6500  
Fax: (512)-453-0066

**Claims Appendix****Claims:**

1. A method/process of creating a dietary supplement profile for an individual comprising:
  - a) completing a health questionnaire by an individual,
  - b) comparing of the questionnaire information by an individual to a health profile for a person of the individual's age and health history background in a computer data base,
  - c) comparing the individual's health information to standardized profiles based on age, sex, physical activity, dietary habits, past medical history to achieve optimal health and wellness,
  - d) generating a computer-implemented dietary supplement profile based on the individual's health information listing the vitamins, minerals, amino acids, enzymes, and herbs to achieve optimal health and wellness.
2. The method/process of creating a dietary supplement profile of claim 1, wherein step (b) comprises comparing the questionnaire information by the individual and information provided by a physical examination to a health profile for a person of the individual's age and health history background in a computer database.
3. The method/process of creating a dietary supplement profile of claim 1, wherein step (b) comprises comparing the questionnaire information provided by the individual and information provided by laboratory studies to a health profile for a person of the individual's age and health history background in a computer database.
4. The method/process of creating a dietary supplement profile of claim 1, further comprises adding a list of commercially available products that provide the dietary supplements listed to achieve optimal health and wellness.
5. The method/process of creating a dietary supplement profile of claim 1, further comprises adding a plan for weight management.

**FIG. 1**

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**NOTE:** In light of the 1.12 problems, the examiner is interpreting the claims and applying prior art as best as possible using these interpretations. These interpretations of claim language are for examination purposes only.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5 are rejected under 35 U.S.C. §103(a) as being unpatentable over Summerell et al (U.S. Patent No. 5,937,387) in view of Riley (U.S. Patent No. 5,976,568)

In reference to claim 1, Summerell et al teach a method for creating a dietary supplement profile for an individual comprising:

- completing a health questionnaire by an individual; (Figures 4-6; col. 9, lines 15-31)
- comparing the information gathered from the questionnaire to health standard information for a person of the individual's age and health history background (col. 8, line 30-41; line 53-col. 9, line 14; col. 11, lines 18-29)
- comparing for differences in the individual's health the information to standardized profiles based on age, sex (gender), physical activity (e.g. energy expenditure),

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LUMA CIRCUIT  
P64 7-9  
Supplementary

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being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claim 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Summerell et al. (US Patent No. 5,937,387)

In reference to claim 1 and 6, Summerell et al teach a method for customizing a personal wellness plan for an individual comprising:

- completing a health questionnaire by the individual; (Figures 4-6; col. 9, lines 15-31)
- comparing the information gathered from the questionnaire to a standard health profile in a computer database; (col. 11, lines 18-29)
- generating a dietary supplement profile based on the individual's health information, said dietary supplement profile including a recommendation for the individual to take at least one of the following nutrients: vitamins, minerals, amino acids, enzymes and herbs. (Figures 18-25)

*NOT INCLUDED*

Summerell et al teach a method and system for providing a personalized health and fitness profile for an individual. The individual completes a questionnaire relating to his/her overall health. The results from the individual's questionnaire are compared to a stored standard health profile which is based on individuals of comparable age and health risk. The system then generates health recommendations for the user including suggestions on nutritional supplements (e.g. vitamins and minerals) to take to improve the user's health. (i.e. dietary supplement profile) (see figures 18-25, especially 22-25)

RELATED PROCEEDINGS APPENDIX

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

## UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCESEx parte EDWARD J. PETRUSAppeal No. 2003-2002  
Application No. 09/444,660

MAILED

JUL 21 2004

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

ON BRIEF

Before MCQUADE, BARRETT, and NASE, Administrative Patent Judges.MCQUADE, Administrative Patent Judge.DECISION ON APPEAL

Edward J. Petrus appeals from the final rejection of claims 1 through 5, all of the claims pending in the application.<sup>1</sup>

THE INVENTION

The invention relates to a method of creating a dietary supplement profile for an individual. Representative claim 1 reads as follows:

1. A method/process of creating a dietary supplement profile for an individual comprising:
  - a) completing a health questionnaire by an individual,
  - b) comparing of the questionnaire information by an individual to an optimal health profile in a computer data base,

<sup>1</sup> Claims 2 and 3 have been amended subsequent to final rejection.

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- c) adjusting for differences in the individual's health information when compared to an optimal health profile,
- d) generating a computer-implemented dietary supplement profile based on the individual's health information listing the vitamins, minerals, amino acids, enzymes, and herbs suggested for an optimal health profile.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Summerell et al. (Summerell)	5,937,387	Aug. 10, 1999
Riley	5,976,568	Nov. 2, 1999

THE REJECTION

Claims 1 through 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Summerell in view of Riley.

Attention is directed to the main and reply briefs (Paper Nos. 17 and 21) and to the answer (Paper No. 20) for the respective positions of the appellant and the examiner regarding the merits of this rejection.<sup>2</sup>

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<sup>2</sup> In the final rejection (Paper No. 8), claims 2 and 3 also stood rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The examiner has since withdrawn this rejection in light of the amendment of claims 2 and 3 subsequent to final rejection (see the advisory action dated November 18, 2002, Paper No. 10).

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### DISCUSSION

#### I. Preliminary matters

The appellant (see pages 1 through 5 in the main brief) raises as issues in the appeal the propriety of (1) the examiner's decision to make "final" the Office action appealed from (Paper No. 8), and (2) the Technology Center Director's decision (Paper No. 12) to deny the appellant's 37 CFR § 1.181 petition (Paper No. 11) requesting withdrawal of the finality of such Office action. As these related matters are not directly connected with the merits of issues involving a rejection of claims, they are not reviewable by appeal to this Board (see In re Hengehold, 440 F.2d 1395, 1403-04, 169 USPQ 473, 479 (CCPA 1971)), and hence will not be further addressed in this decision.

#### II. The appealed rejection

We shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1 through 5 as being unpatentable over Summerell in view of Riley. For the reasons expressed below, claims 1 through 5 are indefinite. Therefore, the standing prior art rejection must fall since it necessarily is predicated on speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our decision in

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this regard rests solely on the indefiniteness of the claimed subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the § 103(a) rejection.

### III. New rejections

The following new rejections are entered pursuant to 37 CFR § 1.196(b).

Claims 1 through 5 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.

Id.

As indicated above, independent claim 1 recites a method/process of creating a dietary supplement profile of an

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individual comprising, inter alia, the steps of comparing an individual's health questionnaire information to an "optimal health profile" in a data base and "adjusting" for differences in the individual's health information when compared to the "optimal health profile." Read in light of the underlying disclosure, these recitations of the "optimal health profile" and the "adjusting" step render the scope of claim 1, and claims 2 through 5 which depend therefrom, indefinite. The underlying disclosure makes no mention of an "optimal health profile," and instead describes comparison of the questionnaire information to "a health profile for a person of the consumer's age and health history background" (specification, page 2) and/or to "standardized profiles based on age, sex, physical activity, dietary habits, past medical history and other items covered in the questionnaire" (specification, page 3). Neither of these descriptions reasonably depicts an "optimal health profile" or gives any indication as to what an "optimal health profile" might be. Similarly, the underlying specification makes no mention of any type of "adjusting" step corresponding to that recited in claim 1.

The scope of dependent claims 2, 3 and 4 is additionally indefinite in that it is unclear whether the recitations in

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claims 2 and 3 of "a health profile in a computer database" and in claim 4 of "an optimal health profile" refer to the "optimal health profile" recited in parent claim 1 or to some other health profile. With further regard to claim 4, the recitation of "the dietary supplements listed in an optimal health profile" is confusing in light of the description in the underlying specification that the dietary supplements are listed in the dietary supplement profile rather than in an optimal health profile.

Claims 1 through 5 also are rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which lacks a written description of the claimed invention.

The test for determining compliance with the written description requirement of the first paragraph of 35 U.S.C. § 112 is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

In the present case, the disclosure of the application as originally filed would not reasonably convey to the artisan that

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the appellant had possession at that time of a method/process of creating a dietary supplement profile of an individual comprising the steps of comparing questionnaire information to an "optimal health profile" in a data base and "adjusting" for differences compared to the "optimal health profile" as now recited in independent claim 1, or the step of providing "the dietary supplements listed in an optimal health profile" as now recited in dependent claim 4. As alluded to above in connection with the § 112, ¶ 2, rejection, the original disclosure makes no mention of an "optimal health profile," an "adjusting" step or the provision of "dietary supplements listed in an optimal health profile."

#### SUMMARY

The decision of the examiner to reject claims 1 through 5 is reversed, and new rejections of these claims are entered pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

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37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner; in which event the application will be remanded to the examiner.

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b).

*John P. McQuade*  
JOHN P. MCQUADE  
Administrative Patent Judge  
BOARD OF PATENT

*Lee E. Barrett*  
LEE E. BARRETT  
Administrative Patent Judge  
APPEALS AND  
INTERFERENCES

*Jeffrey V. Nase*  
JEFFREY V. NASE  
Administrative Patent Judge

JPM/kis